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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,557	10/10/2001	W. Monty Reichert	2455.3US	7868
24247	7590	09/07/2005	EXAMINER	
TRASK BRITT			SNAY, JEFFREY R	
P.O. BOX 2550			ART UNIT	PAPER NUMBER
SALT LAKE CITY, UT 84110			1743	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/973,557	REICHERT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffrey R. Snay	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 17 June 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 26-63 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/25/05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

***Priority***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date as a continuation application under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

In this case, the presently recited "light detection device positioned in a cone of collection angles, said cone of collection angles having an axis oriented substantially orthogonal to a plane of said waveguide film" is neither described nor enabled by the parent applications.

2. This application repeats a substantial portion of prior Application No. 09/412,731, filed 10/05/1999, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

***Claim Rejections - 35 USC § 112***

3. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. All of the claims presently under examination contain a limitation of "light detection device positioned in a cone of collection angles, said cone of collection angles having an axis oriented substantially orthogonal to a plane of said waveguide film." This limitation is nowhere mentioned, described, explained, nor enabled by the specification. The specification is silent as to what is intended by the scope of the limitation, and the meaning of the phrase "cone of collection angles". In view of the specification's failure to meaningfully define the limitation, one of ordinary skill in the art would be unable to make and/or use the invention as claimed.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All of the claims presently under examination contain a limitation of "light detection device positioned in a cone of collection angles, said cone of collection angles

having an axis oriented substantially orthogonal to a plane of said waveguide film." This limitation is nowhere mentioned, described, nor explained by the specification. The specification is silent as to what is intended by the scope of the limitation, and the meaning of the phrase "cone of collection angles". In view of the specification's failure to meaningfully define the limitation, one of ordinary skill in the art would be unable to clearly ascertain the meets and bounds of what applicant regards as the invention claimed.

6. Because the intended scope and meaning of the recited limitation of a "light detection device positioned in a cone of collection angles, said cone of collection angles having an axis oriented substantially orthogonal to a plane of said waveguide film" cannot be reasonably construed with any certainty, no further examination on the merits with respect to the prior art can be reasonably conducted.

#### ***Response to Arguments***

7. Applicant's arguments filed 06-17-2005 have been fully considered but they are not persuasive. Applicant contends that the presently claimed limitation of a " light detection device positioned in a cone of collection angles, said cone of collection angles having an axis oriented substantially orthogonal to a plane of said waveguide film" is adequately supported and enabled by Figure 5 of the specification. In particular, Applicant states in the above-noted reply that Figure 5 illustrates "collection angles as a group of dashed lines as well as detector 502 positioned within the collection angles."

The argument is not persuasive because Figure 5 fails to describe or enable any intended scope of the noted limitation. The figure fails to depict any angles, any cone of angles, nor any definition of what would be contemplated as a "collection angle" or a "cone of collection angles." Applicant's argument that the cone of collection angles is represented by dashed lines in the figure appears misplaced because the figure fails to identify any angles. Furthermore, the figure fails to define what is intended as a "collection angle." For example, are such angles determined by the sample substrate or by the detector? Finally, the figure fails to make any reference to what might be contemplated as a "cone of angles."

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as technical background generally related to applicant's field of endeavor.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Snay whose telephone number is (571) 272-1264. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey R. Snay  
Primary Examiner  
Art Unit 1743

jrs